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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,135	12/07/2001	Neil Russell Foster	HILLS1100	8942
28213	7590	12/06/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP			OH, SIMON J	
4365 EXECUTIVE DRIVE			ART UNIT	
SUITE 1100			PAPER NUMBER	
SAN DIEGO, CA 92121-2133			1618	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,135

Applicant(s)

FOSTER ET AL.

Examiner

Simon J. Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Papers Received

Receipt is acknowledged of the applicant's amendment, response, and petition for extension of time, all received on 08 September 2005.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-24 and 27-29 under 35 U.S.C. 103(a) over Merrified *et al.* in view of Manning *et al.* is maintained.

Response to Arguments

Applicant's arguments filed 08 September 2005 have been fully considered but they are not persuasive.

It is the position of the examiner that the disclosure of the prior art still reads on the recited limitations of the instant claims. Although the examiner understands the difference between the processes disclosed in the Merrified *et al.* patent and that disclosed in the instant claims, such a distinction has not been embodied within the language of the instant claims. That is, the instant claims never specify at which point the substance of interest precipitates, whether it does so at the point of contact between the solvent and anti-solvent streams, or at a point

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further downstream. Therefore, the examiner cannot withdraw the prior art rejection of record on this point.

Furthermore, regardless of how the applicant characterizes the disclosure of the Merrified *et al.* patent in terms of the selection of an anti-solvent, it does not change the fact that anti-solvents such as ethane and ethylene, which read on the instant claims, are disclosed within the prior art. Therefore, the applicant's argument based on the preferred choice of anti-solvent within the prior art is founded upon a narrow interpretation of both the claims and the prior art. The prior art remains relevant for all that it contains, not just preferred embodiments, such that non-preferred and alternative embodiments disclosed within the prior art can be properly applied against the instant claims. Thus, the disclosure of carbon dioxide as a preferred anti-solvent does not nullify the validity of alternative selections of anti-solvents such as ethane and ethylene. Therefore, the applicant's arguments on this point do not successfully rebut the examiner's rejection of the instant claims. See MPEP § 2111 and 2123.

Finally, the examiner does not agree with the applicant's arguments against the Manning *et al.* reference. Although the applicant argues against the disclosure in Manning *et al.* of hydrophobic ion pair complexes, there is nothing within the language of the instant claims that bars the use of such complexes. Here, the examiner has interpreted the term "including" in the instant claims to be equivalent to the more commonly used term "comprising", rather than the more limiting terms "consisting of" or "consisting essentially of". Such an interpretation is wholly consistent with current Office practice. See MPEP § 2111.03. Thus, the broad scope of the instant claims, as embodied by its open language, allows for the inclusion of ion pair complexes.

Thus, the prior art rejection of record will be maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

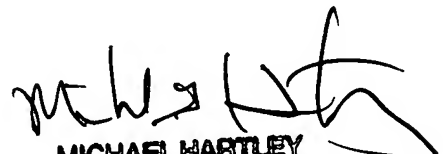
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Simon J. Oh
Examiner
Art Unit 1618

sj0


MICHAEL HARTLEY
PRIMARY EXAMINER